REMARKS

Amendment to the Claims

Claims 1-3 and 5-7 remain open for prosecution and claims 8-10, 12 and 13 are withdrawn but are requested to be rejoined should claims 1-3 and 5-7 be held to be allowable (see MPEP 806.05(c) II. Subcombination Essential to Combination). Claims 9 and 10 have been amended to correct a typographical error with regard to claim dependency. It is believed that no new matter has been entered.

A Notice of Appeal is being filed concurrently with this response.

35 U.S.C. 102(b) rejection

Claims 1-3 and 5-7 were rejected as being anticipated by Lawrence (U.S. Patent 3,660,673).

Response to Examiner's "Response to Arguments"

Applicants' claim 1 is the broadest of the pending claims and even this claims requires the following five elements are ***simultaneously*** present in the claimed adhesive:

(1) it must be a hot-melt pressure sensitive adhesive;

(2) the adhesive comprises of

- (a) 100 parts by mass of the non-thermoplastic polymer
- (b) 1 to 200 parts by mass of at least one tackifying resin
- (c) a mixture of blocking-agent free isocyanates wherein the isocyanates are a mixture of isocyanates distinguished by different reactivities;

(3) the adhesive comprises of 8 mmol to 5 mol of reactive isocyanate groups of the isocyanate per kilogram of the non-thermoplastic elastomer.

It is believed that the Lawrence reference was previously rescinded as a reference rejecting the claims under 35 U.S.C. 103 because the Examiner recognized at the time that the present invention is a hot-melt adhesive whereas Lawrence is a solventborne adhesive which are two distinctively different classes of adhesive. With regard to the hot-melt limitation, the Examiner misinterprets Lawrence's teaching about the thin film being "allowed to dry" and "irradiation at 60°C" as being indicative of a hot-melt

adhesive; it does not. Illustrative of Lawrence's process is the use of a solvent mixture of toluene/hexane/methylethylketone (see Examples 1 and 3) which have boiling points of 110.6°C, 69°C and 80°C respectively which would not reasonably be believed to be completely driven off by the process conditions disclosed by Lawrence which would be consistent with the fact that Lawrence himself does not characterize his invention as a hot-melt adhesive.

Lawrence also does not teach the use of at least one tackifying resin.

The Examiner also erroneously ascribes that Lawrence teaches the use of two different isocyanates in Example 2. However, this portion of Lawrence merely discloses the key inventive portion of their invention, i.e. the trimerization of an isocyanate; the end product of the trimerization process described is a single product. Even if Lawrence had taught the use of two separate isocyanate or that their trimerization process resulted in two different isocyanates, the Examiner has not established that these different isocyanates have different reactivities. If the Examiner is basing his reasoning on inherency, the Examiner has the initial burden of showing that such property is inherent (the examiner is apparently also relying on inherency to support the proposition that Lawrence inherently teaches blocking-agent free isocyanates and that the ratio of isocyanates to non-thermoplastic elastomers) and this burden has not been met to date.

Examiner's comments to applicants' comments "not germane to the claims"

While the Examiner is not barred from reapplying a previously used reference, the applicants' objected to the Examiner's characterization of the Lawrence reference as being "newly discovered" when in fact the reference had been used before in an obviousness rejection. In addition, while the Examiner's comments about "new considerations" and "different search strategies" would normally be acceptable explanations for the reapplication of the Lawrence reference, in the instant application they are not, i.e. the applicants' claims were originally rejected by the Lawrence reference for obviousness (but not anticipation) and were broader in scope than the claims presently under consideration. How can the present claims, which are narrower in scope than the claims originally rejected by Lawrence, be anticipated by Lawrence when the broader claims (which encompass the scope of the present claims) were held by the same Examiner not to be anticipated?

Moreover, the second application of the Lawrence reference by the Examiner occurred after the applicants' adopted the Examiner's suggestion for allowed subject matter, i.e. the limitation of original

claim 4 was incorporated into claim 1.

Given that this application has now had one restriction, two non-final rejections and two final rejections, the applicants request that if the application is not held in condition for allowance and if the Examiner is not a primary examiner, that the Advisory Action or subsequent office action be reviewed and signed by the Examiner's supervisory patent examiner.

The applicants also note that the 3-year prosecution date for accrual of Patent Term Adjustment (PTA) time was 11 August 2003 and as of the date of this response, the applicants' PTA time stands at 308 days and counting.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (7 pages) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: **14 June 2004**

By: Agata Glinska
Agata Glinska